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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BERMAN, ALYSIA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,606

Applicant(s)

SIMONNET ET AL.

Examiner

Alysia Berman

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-20 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of the amendment filed May 28, 2002. Claims 1, 4-8, 10, 11, 16 and 19 have been amended. Claims 24-28 have been added. Claims 1-28 are pending. Claims 17 and 21 have been withdrawn as directed to a non-elected invention.

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-16 and 18-20, and the polymeric emulsifier polyisobutylene with a modified succinic terminal group in Paper No. 6 is acknowledged. Claims 22 and 23 and equivalent species of emulsifier were examined with the elected invention. The traversal is on the ground(s) that the methods of claims 17 and 21 cannot be practiced without the compositions of claims 1 and 16. This is not found persuasive because the requirements for making a restriction or election of species are whether the claims are patentably distinct and examination of all the inventions would cause a serious burden. In this case, the methods of claims 17 and 21 are patentably distinct from the compositions of claims 1 and 16. A separate search and examination would have to be conducted for each invention would which place an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 17 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 7 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is indefinite because it is unclear what Applicant intends to encompass with anhydride. Does Applicant intend to encompass any anhydride or only the succinic acid anhydride? If Applicant intends to encompass only the succinic acid anhydride, amendment of the claim to read, "succinic acid and succinic anhydride" would overcome this rejection.

Claim 25 is indefinite because the term "wherein" is recited twice in line 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-7, 9, 11-16, 18-20, 22 and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,980,922 (922).

US '922 is directed to personal cleansing articles that contain a water-in-oil emulsion (abstract). The emulsion comprises an oily phase (lipid phase), an aqueous phase containing water and an emulsifier (abstract). The emulsifier is preferable the

Art Unit: 1617

reaction product of a polyisobutylene-substituted succinic acid and an amine available from Lubrizol® (col. 13, lines 11-22 and 55-57). See the examples beginning at column 17 for emulsion containing the instantly claimed components within the instantly claimed concentration ranges, a hydrocarbon oil in the oily phase (petrolatum) and a cosmetic adjuvant. Petrolatum is considered a make-up removing oil as claimed in instant claim 22.

The limitation of claim 4 regarding the ability of the emulsifier to reduce the interfacial tension between the aqueous phase and oily phase by at least 10 mN/m is an inherent property and is not given patentable weight. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. Additionally, this is not a required limitation of the claim because it is based on the possibility of when the emulsifier is present at a concentration of 0.01 wt.%.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1617

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4-7, 9, 11-16, 18-20 and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,980,922 (922) in view of Michalun and Michalun, Milady's Skin Care and Cosmetic Ingredients Dictionary, 1st Ed., Milady Publishing Co., Albany, NY, (1994) pages 143, 144, 180, 225 and 226 (Michalun).

US '922 teaches all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not teach the fatty esters of instant claim 23.

Michalun discloses various fatty esters of C1-17 alcohols with fatty acids having at least 12 carbon atoms that are conventional ingredients in cosmetic compositions. See ethyl linoleate, ethyl linolenate, 2-ethylhexyl isostearate, isopropyl isostearate, isopropyl myristate, isopropyl palmitate, isopropyl stearate, octyl palmitate, octyl stearate and octyl hydroxystearate, for example. Octyl palmitate is disclosed to have moisturizing and solvency properties.

Art Unit: 1617

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '922 and add the fatty esters of Michalun for their art-recognized cosmetic properties.

Claims 1-16, 18-20 and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,980,922 (922) in combination with US 4,708,753 (753).

US '922 teaches all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not teach that the polyolefinic apolar component of the polymer has from 60 to 700 carbon atoms, the acids of claim 8 or the fatty acid esters of claim 23.

US '753 discloses polymers made from polyolefins such as polyisobutylene and acids such as maleic acid and succinic acid. See column 8, line 10 to column 10, line 19. At column 8, line 67 to column 9, line 4 US '753 discloses that the polyolefins of the polymers have from about 20 to about 500 carbon atoms, which overlaps with the instantly claimed range of carbon atoms of claim 2. US '753 also discloses fatty acid esters encompassed by instant claim 23. These fatty acid esters are conventional ingredients in cosmetic compositions as evidenced by Michalun above. US '922 discloses at column 13, lines 17-19 that the preferred emulsifiers are described in US '753.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the emulsion of US '922 and add an emulsifier and a fatty acid ester of US '753 with the reasonable expectation of obtaining emulsions with improved water retention levels and reduced tackiness.

Response to Arguments

Applicant's arguments with respect to claims 1-16, 18-20, 22 and 23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

Art Unit: 1617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
August 2, 2002


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